UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,206	07/06/2001	Takahiro Koga	2000-205779US	3583

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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/899,206	KOGA ET AL.
	Examiner	Art Unit
	Namrata Boveja	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 September 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-31</u> is/are pending in the application.

    4a) Of the above claim(s) <u>3-12,15-19, 22-25, 32, and 33</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) <u>1,2,13,14,20,21 and 26-31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 July 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to communication filed on 09/01/2006.

2.   Claims 3-12,15-19 and 22-25 have been withdrawn. Claims 32 and 33

have been cancelled. Claims 1, 2, 13, 14, 20, 21 and 26-31 are presented for

examination.

3.   Amendments to the claims have been entered and considered.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner
> and process of making and using it, in such full, clear, concise, and exact terms as to
> enable any person skilled in the art to which it pertains, or with which it is most nearly
> connected, to make and use the same and shall set forth the best mode contemplated by
> the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject

matter, which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention.

Specifically, the claim recites selecting different values of response requests, the

values corresponding to different kinds of commercial transactions, and the

evaluation means sending said reward data further based on said response

request, and this constitutes new matter, as this claim limitation is not supported

by the specification. Applicant did not point to any support in the specification for

this amended claim. The closest thing the claims relate to in the specification is

on pages 48 and 49, where it is stated that a contribution degree by the user is

evaluated and a discount is given to the user based on the evaluation scores (i.e.

if a user is interested in purchasing product A, a discount coupon may be given

for the purchase of product A). Furthermore, the user selects what kind of a

reward the user wants by making a choice. This however does not equate to

what is claimed especially in terms of selecting different values corresponding to

different kinds of commercial transactions. These features are interpreted to

mean that a customer is given a reward to influence the purchase of a product.

Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless – (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5.   Claims 1, 2, 13, 14, 20, 21, and 26-28, are rejected under 102(a) as being

anticipated by Bendinelli et al (Patent Number 6,061,719 hereinafter Bendinelli).

In reference to claim 1, Bendinelli teaches an information providing system

comprising: an information providing means having *means for storing a customer*

information data representing attributes of a customer (i.e. storing data regarding

sites of interest to the customer) (col. 5 lines 50-54), means for generating a first

information data reflecting a pre-determined advertisement (i.e. does the

customer want to continue seeing the pre-determined advertisement) (col. 4 lines

45-67 and col. 5 lines 50-54), means for generating a customer-specific

advertisement data (i.e. customer views the advertisement of interest and the

ongoing display of advertisements is stopped) (col. 4 lines 45-67) based at least

in part, on said customer information data (i.e. data regarding sites of interest to

the customer) (col. 5 lines 50-54) and said first information (i.e. the customer

selects to continue viewing a particular advertisement) (col. 4 lines 45-67), and

including a communication address corresponding to said customer (i.e. an

embedded URL in the television signal for display on a different window) (col. 6

lines 31-39), a first information transfer path (i.e. television program sent via an

antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13) *for*

transmitting said first information data to a plurality of destinations, and a second

information *transfer path for transmitting said customer-specific advertisement*

data to a destination based on said communication address (i.e. an embedded

URL in the television signal for display on a different window) (col. 6 lines 31-39);

and an information receiving terminal *constructed and arranged to receive* said

first information *data* and said *customer-specific advertisement data* via said first

and second information transfer paths respectively (i.e. a television or computer)

(col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein said first

information transfer path, and said second information transfer paths are different

from one another *(i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines*

67 to col. 6 lines 11).

6.   In reference to claims 2, 14, and 21, Bendinelli teaches an information

providing system, method, and code comprising: *a first information providing*

means and code for transmitting to a plurality of destinations via a first

information transfer path, *a first information data reflecting* a pre-determined

advertisement (i.e. television program sent via an antenna, a cable network, or a

satellite receiver) (col. 5 lines 7-13); *a second information providing means and*

code having means for storing a customer information data representing

attributes of a customer (i.e. storing data regarding sites of interest to the

customer) (col. 5 lines 50-54), and having means for generating and transmitting,

via a second information transfer path, *customer-specific advertisement data*

having a destination address corresponding to said customer (i.e. customer can

select a particular advertisement URL and stop the ongoing display of

advertisements) (col.4 lines 45-67 and col. 5 lines 3-6), said customer-specific

advertisement data based, at least in part, on said customer information (i.e.

data regarding sites of interest to the customer) (col. 5 lines 50-54) and on said

first information *(i.e. the customer selects to continue viewing a particular*

advertisement) (col. 4 lines 45-67); and an information receiving terminal

accessible by said customer, *constructed and arranged to receive* said first

information *data* via said first information transfer path and said *customer-specific*

advertisement data via said second information transfer path (i.e. a television or

computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein said

first information *path and said second information path are different from one*

another (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to

col. 6 lines 11).

7.   *In reference to claim 13, Bendinelli teaches an information providing*

method, comprising: storing a customer data representing attributes of a

customer (i.e. storing data regarding sites of interest to the customer) (col. 5 lines

50-54); transmitting advertisement data via a first information transfer path (i.e.

television program sent via an antenna, a cable network, or a satellite receiver)

(col. 5 lines 7-13), and a customer-specific advertisement data based on said

advertisement data and said customer data and having a destination address

corresponding to said specific customer via a second information transfer path

(i.e. customer can select a particular advertisement URL and stop the ongoing

display of advertisements) (col.4 lines 45-67 and col. 5 lines 3-6); and receiving

said advertisement data and said customer-specific advertisement data first

information and said second information via said first and second information

transfer paths respectively at an information receiving terminal associated with

said customer (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67

to col. 6 lines 11), wherein, said transmitting of said advertisement is to a plurality

of customers and said transmitting of said customer-specific advertisement is, in

accordance with said destination address, to said information receiving terminal

(i.e. information is sent to the television or computer), and wherein said first

information transfer path, and said second information transfer path are different

from one another (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines

67 to col. 6 lines 11).

8.   In reference to claim 26, Bendinelli teaches the information providing

system, wherein the first information providing means includes a broadcasting

system (i.e. an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-

13) and said second information providing means is an information management

center (i.e. a network) (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).

9.   In reference to claim 27, Bendinelli teaches the information providing system, wherein the first information transfer path is a wireless *media* (i.e. a satellite receiver) (col. 5 lines 7-13) and the second information transfer path *includes* a *wired* network (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).

10.   In reference to claim 28, Bendinelli teaches the information providing system, f*urther comprising means for said customer to send a response request for said customer-specific advertisement data to wherein said second information providing means (i.e. customer can select a particular URL using a keyboard, mouse, and a remote control) (col. 4 lines 45-67 and col.5 lines 54-57), and wherein said means for generating and transmitting said customer-specific advertisement data transmits said customer-specific advertisement data* in response to *receiving said response request (i.e. customer can view the selected advertisement and stop the ongoing display of advertisements) (col. 4 lines 45-67)*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 29-31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bendinelli in view of Grapes.

In reference to claim 29, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11) *further comprising: means for said customer to send a response request, via said second transfer path for said customer-specific advertisement data to said second information providing means, and for including with said response request a data identifying said customer and identifying said pre-determined advertisement (i.e. customer can select to view a specific advertisement and stop the ongoing display of advertisements) (col. 4 lines 45-67).* Bendinelli does not teach the system comprising evaluation means for *sending reward data to* said customer *based, at least in part, on said customer sending said response request* via said second information transfer path. Grapes teaches evaluation means for *sending reward data to* said customer *based, at least in part, on said customer sending said response request* via said second information transfer path (i.e. data is evaluated regarding customer and transaction history and coupons are issued to influence purchasing) (abstract, col. 8 lines 13-16, col. 9 lines 1-14, col. 14 lines 41-44 and 51-53, and col. 15 lines 14-18). It would have been obvious to modify Bendinelli to include evaluation means for *sending reward data to* said customer *based, at least in part, on said customer sending said response request* via said second information transfer path in order to enable advertisers *to provide incentives to customers for buying their advertised products.*

12.   **Disclaimer:** Claim 30 was found to be deficient under U.S.C. 112 first

paragraph. To the extent the claimed invention was understood, the following art

was applied.

In reference to claim 30, Bendinelli teaches the information providing

system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6

lines 11). Bendinelli does not teach the system wherein, *said means for said*

customer to send a response request includes means for said customer to select

and send one or more from among a plurality of different values of response

requests, said values representing a corresponding plurality of different kinds of

commercial transactions, and said evaluation means sends said reward data

further based on the value of the said response request (i.e. customer is given

incentives to influence the purchase of a product). Grapes teaches the system

wherein, in case that first information includes advertising information, said

evaluation means makes an evaluation for rewarding said customer responding

to a contribution degree to commercial transaction achievements relating to

products or services as an object of an advertisement (i.e. customer is given

incentives to influence the purchase of a product) (col. 3 lines 41-48 and 56-65

and col. 15 lines 14-18). Grapes also teaches evaluation means for *sending*

reward data to said customer *based, at least in part, on the value of said*

response request (i.e. data is evaluated regarding customer and transaction

history and coupons are issued to influence purchasing) (abstract, col. 8 lines 13-

16, col. 9 lines 1-14, col. 14 lines 41-44 and 51-53, and col. 15 lines 14-18). It

would have been obvious to modify Bendinelli to include evaluation means for

making an evaluation for rewarding said customer responding to a contribution

degree to commercial transaction achievements relating to products or services

as an object of an advertisement to enable advertisers to provide better targeted

advertising to customers to influence purchasing done by the customers by

offering incentives at the time of purchase. It would have been obvious to modify

Bendinelli to include evaluation means for *sending reward data to* said customer

based, at least in part, on the value of said response request in order to enable

advertisers *to provide incentives to customers for buying their advertised*

products.

13.   In reference to claim 31, Bendinelli teaches *the information providing*

system further comprising: means for said customer to send a viewing response

data identifying receipt of said advertisement data (i.e. the customer can select

an advertisement by clicking on it with a mouse, a keyboard, or with a remote,

and the list of the selected advertisements can be stored on the set-top box) (col.

5 lines 50-57); means for collecting a database of said viewing response data

(i.e. a list of advertisements clicked on by the customer is maintained in the set-

top box) (col. 5 lines 50-54). Bendinelli does not teach a means for analyzing

said viewing response data to generate an evaluation data representing statistics

of customer viewing of said pre-determined advertisement. Grapes teaches a

means for analyzing said viewing response data to generate an evaluation data

representing statistics of customer viewing of said pre-determined advertisement

(col. 8 lines 13-16, col. 9 lines 8-13, and col. 14 lines 39-48). It would have been

obvious to modify Bendinelli to include a means for analyzing said viewing

response data to generate an evaluation data representing statistics of customer

viewing of said pre-determined advertisement in order to enable advertisers to

evaluate and analyze relevant markets and the customer response rate to

advertisements.

Response to Arguments

14.   After careful review of Applicant's remarks/arguments filed on 09/01/2006,

the Applicant's arguments with respect to claims 1, 2, 13, 14, 20, 21 and 26-31

are presented for examination and have been fully considered but are moot in

view of the new ground(s) of rejection. Amendments to the claims have been

entered and considered.

15.   The previously made rejections under 35 USC § 112 have been removed

in view of the amendment by applicant. However, applicant's amendment has

lead to a new 35 USC § 112 rejection.

16.   Applicants additional remarks are addressed to new limitations in the

claims and have been addressed in the rejection necessitated by the

amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.
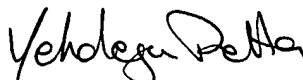
If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-

free).

NB

November 8th, 2006

RETTA YEHDEGA
PRIMARY EXAMINER